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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/457,207      | 12/07/1999  | JEREMY VANDER WOUDE  | MPATENT.160A        | 7416             |

20995 7590 06/27/2003

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EXAMINER

KUMAR, PANKAJ

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 2631     |              |

DATE MAILED: 06/27/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/457,207

Applicant(s)

WOUDE, JEREMY VANDER

Examiner

Pankaj Kumar

Art Unit

2631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on 6/4/2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) Claim(s) 1,3-5,8 and 11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,3-5,8 and 11 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.  
4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
5) Notice of Informal Patent Application (PTO-152)  
6) Other:

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 6/4/2003 have been fully considered but they are not persuasive.
2. Applicant argues that it is illogical for a modem under test to provide elements of the claimed device for testing the operation of a modem. This is respectfully traversed. As indicated the title in Rahamim, there is such a thing as 'self-testing'.
3. Applicant argues that it is not inherent to encase a modem under test in a test device since it is illogical and impractical to do so. This is respectfully traversed. One wants to encase a modem since it has electrical components and thus one wants to avoid possible damage with, for example, water. Also, since a modem tester also has electrical components, one wants to avoid possible damage to it as well for the same reason. Also, since there is such a thing as a modem that can self test, the self test modem would be encased for the same reason.
4. Applicant argues that the signal between elements 140 and 118 do not show a communication coupled with the computer. This is respectfully traversed. As indicated in a prior action, 112 is coupled to 140 which is coupled to 118 and signals in between. Accordingly, the signal between 140 and 118 is eventually coupled to the computer via other components.
5. As per claim 5, applicant argues that element 140 is not a modem since it is a modem microcontroller. The argument is respectfully traversed. Since element 140 is a modem microcontroller which is being tested, and since element 140 is part of a modem, element 140 is a modem which is being tested. Even if only a part of a modem is being tested, one can say that the modem is being tested.

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6. Also as per claim 5, applicant argues that elements 118, 120 and 132 are portions of a modem and thus cannot be considered as a modem testing device. This is respectfully traversed. Elements 118, 120 and 132 are portions of a modem and the modem is self testing which is using elements 118, 120 and 132 during the test; therefore, elements 118, 120 and 132 can be considered as a modem testing device.

7. As per the limitation of the alternate communication link, the office did not improperly point to an item as being the modem under test in one claim and then point that same item as being the testing device in the same claim of the rejection.

8. As per claims 8 and 11, applicant says that the elements from the reference have been mislabeled and misidentified without pointing out any specifics. Applicant has not argued mislabeling and misidentifying for the other claims discussed and accordingly, for claims 8 and 11, applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

9. Applicant argues that Rahamim does not show a modem, a testing device, and a computer. This is respectfully traversed. Rahamim shows a modem with 140. Rahamim shows a modem testing device with 118, 120, 132. Rahamim shows a computer with 112.

*Response to Amendment*

*Claim Rejections - 35 USC § 103*

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1, 3, 4, 5, 8, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rahamim et al. See prior action for details.

*Conclusion*

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pankaj Kumar whose telephone number is (703) 305-0194. The examiner can normally be reached on Monday through Thursday after 8AM to after 6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi H. Pham can be reached on (703) 305-4378. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

PK  
June 26, 2003

  
CHI PHAM  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600  
*6/26/03*